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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/071,354

02/08/2002

Brian C. Miller

5410

2806

7590

02/24/2004

Terry T. Moyer  
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EXAMINER

BEFUMO, JENNA LEIGH


ART UNIT

PAPER NUMBER

1771

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/071,354	<b>Applicant(s)</b> MILLER ET AL. 	
	<b>Examiner</b> Jenna-Leigh Befumo	<b>Art Unit</b> 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,6 and 8-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6 and 8-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) .<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)               |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The Amendment submitted on December 23, 2003, has been entered. Claims 2, 4, and 7 have been cancelled. Claims 1, 3, 5, 6, 8 – 11, 14, and 17 – 29 have been amended. Therefore, the pending claims are 1, 3, 5, 6, and 8 – 29.
2. The cancellation of claims 2, 4, and 7 renders the rejections to those claims moot.
3. The 35 USC 102 rejection to claims 1 – 6 and 22 – 29 based on Groten et al. (5,899,785) are withdrawn since the claim has been amended to include limitations of claim 7. However, a new rejection to claim 1 based on Groten et al. is set forth below.
4. The 35 USC 102 rejection to claim 1 based on Vigo et al. (5,897,952) are withdrawn since the claim has been amended to include limitations of claims 2, 4, and 7. However, a new rejection to claim 1 based on Vigo et al. is set forth below.

### ***Double Patenting***

5. Claims 1 – 29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21 and 42 of copending Application No. 10/071,297. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of claims 1 – 29 encompasses the scope of the products recited in claim 21 and 42 of Application No. 10/071,297.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The Applicant has decide not to address the issue of double patenting until the remaining rejections have been withdrawn. However, it is noted that until the double patenting rejection is overcome by a terminal disclaimer or arguments the claims will not be allowable.

***Claim Rejections - 35 USC § 102/103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 3, 5, 6, and 8 – 29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Groten et al.

The features of Groten et al. have been set forth in the previous Office Action. Since the limitations of claim 7 have been added to claim 1, claims 1, 3, 5, and 22 – 29 are now rejected for the reasons set forth in section 10 of the previous Office Action.

***Claim Rejections - 35 USC § 103***

8. Claims 1, 3, 5, 6, and 8 – 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vigo et al. in view of Groten et al.

The features of Vigo et al. have been set forth in the previous Office Action. Since the limitations of claims 2, 4, and 7 were added to claim 1, claim 1 is now rejected for the reason set forth in section 11 of the previous Office Action.

***Response to Arguments***

9. Applicant's arguments filed December 23, 2003 have been fully considered but they are not persuasive. With respect to the 35 USC 102/103 rejections based on Groten et al. the Applicant argues that Groten et al. fails to teach the claimed properties because Groten et al. does not disclose any specific chemicals or combination of chemicals (Response, page 10). However,

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it is noted that the features upon which applicant relies (i.e., specific chemicals or combination of chemicals) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the prior art does not need to teach specific chemicals.

Further, the Applicant states that the untreated fabric in the comparative examples of the Applicant's disclosure are considered to be similar to Groten et al. and show that Groten et al. would not have the claimed properties (Response, page 10). However, while Groten et al. may not teach a specific treatment chemical or combination of chemicals, Groten et al. does teach that anti-pilling treatments, hydrophilic treatments, and dyeing chemical treatments are added to the fabric. Therefore, the fabric would not be comparable to the untreated fabric in the comparative example.

Additionally, the Applicant argues that since Groten et al. does not disclose the claimed property, it is not taught by the prior art (Response, page 11). However, it has been held that as long as there is evidence of record establishing inherency, failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art reference does not preclude a finding of anticipation. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999). Further, it is noted that when the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Thus, the burden has shifted to the Applicant to provide evidence that the properties are not inherent in the prior art materials. *In re Best*, 562 F.2d at

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1255, 195 USPQ at 433. Arguments of counsel cannot take the place of evidence. *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). Therefore, the rejections are maintained.

Additionally, the Applicant argues that the intended use limitations in claims 22 – 29 do distinguish the claimed products from the prior art (Response, page 9). It has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitation. *Ex parte Masham*, 2 USPQ2d 1647 (1987). In this case, the fact that a fabric is used as napery, upholstery, or bedding, does not in any way change the structure of the fabric itself. It only changes where the fabric is or how the fabric is used which is not given any patentable weight. Additionally, it has been held that if a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). In other words, whether or not the prior art teaches a specific use, the prior art can still be used to reject the claims, since the prior art has the claimed structural limitations and is capable of performing the intended use. Thus, the rejection is maintained.

The Applicant also argues that the 103 rejection based on *Vigo et al.* in view of *Groten et al.* lacks a prima facie case of obviousness. Specifically, the Applicant argues that there is no motivation or suggestion for combining the references. However, both references specifically provide motivation as set forth in the rejections. Further, the Applicant argues that the prior art fails to teach the specific chemical composition set forth in the Applicant's disclosure (Response, page 12 – 13). Also, *Vigo et al.* discloses a treatment composition which is different than the

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treatment composition disclosed by the Applicant. Again, it is noted that the claims do not recite any limitations with regards to the chemical composition of the treatment. The claim only requires that the fabric is treated to have pilling resistance, soil release, strength, and abrasion properties. Thus, the chemicals taught by Vigo et al. are not excluded by the claim as written. Further, the fact that the prior art does not teach the exact composition taught by the disclosure is not relevant to the rejection since the chemicals are not recited in the claim and therefore, are not given any patentable weight at this time. Hence, the rejections are maintained.

### *Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

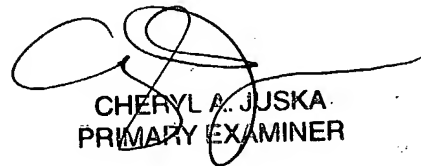
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jenna-Leigh Befumo  
February 12, 2004



CHERYL A. JUSKA  
PRIMARY EXAMINER